

address in connection with future communications is respectfully requested.

Claims 21-31

Independent claim 21 is directed to order servicing equipment for an on-line system that allows a user to order image-based products over the Internet. The order servicing equipment has a computer that receives uploaded digital images over the Internet. The order servicing equipment also has digital printing equipment that prints edited digital images to create prints for framing. The order servicing equipment is configured to present the user with an opportunity to select a given type of frame for a print that has been printed by the digital printing equipment.

In the Office Action, claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. These rejections are respectfully traversed.

Oberg describes a computer system that helps users select frames for their artwork. The system combines images of the user's artwork with images of frames and allows the user to preview a combined image on a display screen before ordering a given frame. The Oberg patent is directed primarily to systems

that are located in a store, although Oberg mentions in passing that customers "will also have access to the software via the Internet which will allows them to make their selections, place orders, and make payment from their home." (See column 7 lines 22-33 of Oberg.)

In general, a user of the Oberg system brings artwork to the store in order to purchase a frame. In the store, the user can use the Oberg system to help generate the preview. Oberg's system is not designed for ordering prints of digital images on-line. At column 7, lines 9-13, Oberg says that "A print command is available to acquire one or more copies of the finished framed order including an image of the order, the bill of material, and the total order cost." Thus Oberg's system can generate order copies, not prints to be framed.

Applicants' order servicing equipment is able to service orders for digital photographic prints and frames for those prints. After a user has uploaded a digital image to the order servicing computer, the digital printing equipment prints that image to create a print for framing. The user is presented with an opportunity to select a given type of frame for that print. This arrangement is explicitly set forth in claim 21. In particular, claim 21 requires that applicants' order

servicing equipment have digital printing equipment that prints digital images to create a print for framing.

Oberg's system works differently. The Oberg system does not create a print for framing. This is because the user in Oberg already has the original artwork that is to be framed in their home. Although Oberg's system prints a confirmation copy of the user's order, there is no reason that the user would frame that order confirmation. The information that is printed in Oberg includes order information such as the bill of material and the total order cost -- clearly not information that is suitable for framing.

The Nozaki and Weisman references fail to make up for the deficiencies in Oberg.

Nozaki relates to a system for generating sound images. The Nozaki patent contains the term "frame." However, Nozaki makes it clear that this term is not being used with its normal meaning. The Nozaki "frames" are not ordinary physical picture frames for hanging on a wall, but are graphic constructs that are used as templates. (See, for example, column 13, lines 32-34, where Nozaki explicitly defines the term "frame" as meaning the "image recording region" in which an image is recorded. Weisman also fails to disclose frames. Because neither Nozaki or Weisman disclose picture frame ordering

capabilities, it is not surprising that neither of these references make up for the failure of Oberg's system to provide a user an opportunity to order a frame for framing the print created by the digital printer.

Claim 21 is therefore patentable over Oberg, whether or not Oberg is combined with the Nozaki and Weisman references as proposed. Claim 21 is therefore in condition for allowance. Claims 22-32 depend from claim 21 and are patentable because claim 21 is patentable. Dependent claims 22- 32 also contain features that further distinguish over the prior art.

As one example, claim 27 is directed to the feature of applicants' invention that allows ordering of albums of different materials. In the Office Action, reference was made to Oberg's abstract in rejecting claim 27. However, the Oberg abstract makes no mention of albums of different materials, let alone on-line ordering of albums of different materials. Claim 27 is therefore allowable for this additional reason.

As another example, claim 31 is directed to using email messages that include URLs that allow recipients to view and order prints through a web browser. In the Office Action, claim 31 was rejected with reference to Weisman and Oberg's summary. However, neither Weisman or Oberg disclose email messages that include URLs that allow a message recipient to

view and order prints through a web browser. Claim 31 is therefore allowable for this additional reason.

As yet another example, claim 32 is directed to ordering prints that include the user as a subject and that include a background different than the background against which the user was originally photographed. In the Office Action, claim 32 was rejected with reference to Weisman. Weisman mentions backgrounds, but they are not the type of backgrounds that are inside a picture. Rather, Weisman's "backgrounds" are the colors of the web pages on which the Memories Online web site displays clients' images. Because the Memories Online web page colors are part of the image, Weisman does not disclose the feature of claim 31 wherein the user can order prints that include both the user as a subject and a background different than the background against which the user was originally photographed. The Memories Online background colors do not take the place of the background against which the user was originally photographed.

Claims 33-40

Independent claim 33 relates to event photography. In particular, claim 33 is directed toward order servicing equipment that allows users to place on-line orders for prints

of digital images taken by a photographer at an event. As set forth in claim 33, the order servicing equipment comprises an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The order servicing computer uses the customer information in providing customers with an opportunity to place an on-line order for a print.

Nothing in Oberg, Weisman, and Nozaki relates to on-line systems for event photography having the customer list and assignment title features of claims 33. Claim 33 is therefore patentable over Oberg, Weisman, and Nozaki. Claims 34-40 depend from claim 33 and are allowable because claim 33 is allowable.

Dependent claims 34-40 also contain additional features not found in Oberg, Weisman, and Nozaki.

For example, claims 34 and 39 are directed to arrangements in which customers are originally photographed against a solid background. The resulting digital image is then manipulated to replace the solid color background with a new background. The Oberg, Weisman, and Nozaki do not disclose this feature. Claims 34 and 39 are therefore patentable for this additional reason.

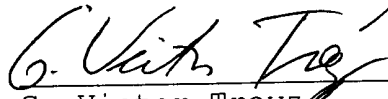
As another example, claim 38 relates to ordering wood and metal framed prints of images taken by the photographer at

the event. Nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints, let alone the ordering of wood or metal framed prints of images taken by a photographer at an event. Claim 38 is therefore patentable for this additional reason.

Conclusion

The foregoing demonstrates that claims 21-40 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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